

27 JAN 2005



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

45

Dara L. Dinner
GlaxoSmithKline
P.O. Box 1539
King of Prussia, PA 19406-0939

In re Application of :
BAKER et al. :
Application No.: 09/786,492 :
PCT No.: PCT/EP99/06423 :
Int. Filing Date: 31 August 1999 :
Priority Date: 09 September 1998 :
Attorney Docket No.: C70366 :
For: NOVEL COMPOSITION AND USE :

DECISION ON PETITION
UNDER 37 CFR 1.181

This decision is in response to applicants' "Petition under 37 CFR 1.181" filed 20 June 2002. No petition fee is required.

BACKGROUND

On 31 August 1999, applicants filed international application PCT/EP99/06423, which claimed a priority date of 09 September 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 16 March 2000. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 09 March 2001.

On 06 March 2001, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee; a copy of the international application; and a preliminary amendment.

On 03 April 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a one-month time limit in which to respond.

On 28 May 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) within the time period set therein.

On 20 June 2002, applicants filed present petition under 37 CFR 1.181 and an executed declaration.

On 18 September 2002, applicants filed "Status Inquiry."

DISCUSSION

In response to the Notification of Abandonment mailed 28 May 2002, applicants state that the Notification of Missing Requirements under 35 U.S.C. 371 was not received. With regards to applicants' request that the holding of abandonment be withdrawn, a proper showing in order to establish that papers were not received as set forth in the Official Gazette at 1156 OG 53 must include the following: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement). Applicants have satisfied item (1) and (2) above.


However, as to item (3) applicants have provided a copy of the docket record which purportedly shows where the paper would have been entered had it been received. The printout of the docket report for this specific application is not sufficient to establish that the Notification of Missing Requirements under 35 U.S.C. 371 was not received and mis-docketed to another application. Accordingly, applicants are required to provide docket records for 03 May 2001, indicating all applications for which a response was due on said date.

CONCLUSION

The Petition to Withdraw Holding of Abandonment under 37 CFR 1.181 is **DISMISSED** without prejudice and the application remains **ABANDONED**.

If reconsideration of the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." Extensions of time under 37 CFR 1.136(a) are permitted.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459

Application No.: 09/786,492

Page

3